

REMARKS

Upon entry of this paper, claim 1 has been amended, claim 9 has been canceled, and no claims have been added as new claims. Thus, claims 1-5 and 7 are presently pending in this application. No new matter has been added. The cancellation of claim 9 should in no way be construed to be an acquiescence to any of the rejections stated. Claim 9 is being canceled solely to expedite the prosecution of the present application. Applicants reserve the option to further prosecute the same or similar claims in the instant or a subsequent patent application.

Drawing Objection

The drawings were objected to under 37 CFR 1.83(a) as not showing every feature of the claimed invention. Specifically, the Office Action asserts that the “ring magnet retaining means” and the “center recess” are not shown in the figure.

Applicants respectfully submit that both elements are clearly shown in the figure. The “ring magnet retaining means” is identified as “ring magnet 8” on page 6, line 20, of the application as filed in the English translation. To clarify that the “retaining means” is directed to retaining the battery and not retaining the ring magnet itself, Applicants have amended claim 1 to indicate “a ring magnet retaining means for retaining batteries in the battery compartment” (see amended claim 1). Applicants further submit that such amendment is not an addition of new matter, or a modification to the claims requiring additional searching, since the amendment merely clarifies language that was already existing in the claim and was clearly described in the specification with regard to the retaining means. Specifically, the specification clearly indicates that the ring magnet retains the battery, as described in page 6, paragraph beginning at line 20, further supporting the clarified interpretation of the claim.

With regard to the “center recess”, this is clearly illustrated in the figure and described in the specification, which states that “there is provided a lower hole 9 of small diameter which exits into the central opening of ring magnet 8”. The end of the lower hole is shown with a small circle in the ring magnet 8 in the figure. In addition, the description of the magnet as a

“ring” magnet clearly indicates a center hole or recess to actually form a “ring” shape. One of ordinary skill in the art can clearly see the recess of the ring magnet as claimed in the figure.

Accordingly, Applicants respectfully submit that all elements claimed are clearly shown in the figure and described in the specification. Reconsideration and withdrawal of these objections is requested.

Claim Rejections – 35 USC § 112

Claim 1

Claim 1 was rejected under 35 U.S.C.112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action asserts that sound tube 6 is external to cylindrical housing 2, and *moves with an applied rotational force operating to transmit sound to the ear canal of the wearer.*

Applicants respectfully submit that the claim language “free of external moving operational elements” is in no way violated by a *fixed* sound tube extending from the housing. The Examiner has distorted the interpretation of “external moving operational element” to mis-describe the claimed element. It is clear from the specification on page 4, paragraph beginning at line 11, that “no movable external operating elements at all are provided in the treatment device, for example, rotatable potentiometers, toggle switches, or pushbuttons. This approach facilitates sealing the treatment device, thereby enhancing the reliability of the treatment device and reducing its production costs.” The sound tube is not an external moving operational element. The rotational force referred to in the Office Action can only be affiliated with one form of attaching the sound tube to the housing, which is by the screw thread shown in the figure. *However, there is no indication in the description that the sound tube rotates to operate after installation.* On the contrary, the specification indicates that, “Sound tube 6 connects in a watertight fashion to housing component 2a” (see page 6, 1st full paragraph). In the instance of the sound tube 6 being coupled to the housing with a screw thread, rotating the sound tube after installation would only serve to unscrew the sound tube and break the watertight seal described.

As such the asserted interpretation of the figures is counter to the invention as described and claimed. *The claims must be interpreted in a manner that is not contradictory to the invention as described in the specification.* Interpreting the sound tube 6 to be an external moving part that *moves with an applied rotational force operating to transmit sound* is clearly not described or claimed in the present invention.

Therefore, Applicants submit that there is no mis-description of the invention with the claim language indicating a device “free of eternal moving operational elements”. Reconsideration and withdrawal of this rejection is requested.

The Office Action further indicates it is unclear how the hole 9 exits into a center recess. Applicants have already substantially addressed this issue with the above remarks concerning the drawings, but now provide additional remarks. The hole 9 is clearly shown as a cylinder passing through the base of the housing. The cylinder clearly ends with a circular opening at the end of the hole 9 at the location of the center recess or hole of the ring magnet 8. Because the holes overlap/intersect there is no way to draw the holes differently. The hole 9 coincides with the recess of the ring magnet 8, as clearly described and illustrated. If the Examiner has another approach to indicating the intersection of two openings of two intersecting holes the figures, Applicants request a telephone interview to discuss such approach.

Claim 9

Claim 9 was objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 9 has been canceled and therefore no longer stands objected.

Claim Rejections – 35 USC § 103*Claims 1, 7 and 9*

Claims 1, 7 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Reiter et al. US 5,724,431 in view of Gnecco US 5,640,457 and further in view of Giannetti US 5,675,657.

The Office Action states that, “Reiter teaches that the volume control dial 60 may be replaced by screw driver adjustable knob for controlling the volume, thereby reading on “free of external moving operational elements” (see OA, page 4). Applicants respectfully submit that this assertion is unsupported on its face. An “adjustable knob for controlling the volume” is clearly a “moving operational element”, in that such a knob is also known as a rotatable potentiometer, or equivalents. The adjustable knob is an element of the Reiter device that controls the volume by moving operation of being rotated by a screw driver. Said differently, the adjustable knob requires movement by the screw driver to perform its operation of controlling the volume. Applicants submit that such knob is clearly an external moving operational element.

It is clear from the pending specification on page 4, paragraph beginning at line 11, that “no movable external operating elements at all are provided in the treatment device” and that by operating or operational elements (as claimed) what is meant is, “for example, rotatable potentiometers, toggle switches, or pushbuttons.” A screw driver adjustable knob for controlling the volume is clearly described as a potentiometer.

The combination of Reiter with Gnecco to indicate that the housing is formed of metal that shields an electronic unit does nothing to address the lack of disclosure in Reiter of a treatment device being “free of external moving operational elements” (see claim 1). The combination of Reiter with Gnecco teaches a device with a metal housing that has an external rotationally movable volume control knob that requires a screw driver to move the knob to control the volume. Such a device is clearly not described by the pending claims of the present application.

Accordingly, the combination of Reiter with Gnecco fails to teach or suggest each element of the rejected claims. Without all elements taught or suggested, the combination of Reiter with Gnecco cannot make the pending claims obvious. As such, Applicants request reconsideration and withdrawal of this rejection.

Claims 2, 3, 4, 5

Claims 2 and 5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Reiter et al. US 5,724,431 in view of Gnecco US 5,640,457 in view of Giannetti US 5,675,657, as applied to claim 1, and further in view of Narisawa US 6,041,128. Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Reiter et al. US 5,724,431 in view of Gnecco US 5,640,457 and in further view of Giannetti US 5,675,657, as applied to claim 1, and in further view of Meier US 6,574,343. Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Reiter et al. US 5,724,431 in view of Gnecco US 5,640,457, in view of Giannetti US 5,675,657, in view of Narisawa US 6,041,128, as applied to claim 2, and further in view of Meier US 6,574,343.

None of the cited references, or their corresponding combinations as cited in the above rejections addresses the inability of Reiter to teach, suggest, or disclose an auditory treatment device having a housing that is, “free of external moving operational elements” (see claim 1) as required by the present invention. Absent such a teaching or suggestion, there can be no obvious rejection. Accordingly, Applicants respectfully request reconsideration and withdrawal of these rejections.

Applicants respectfully submit that unless a *prima facie* case of unpatentability with respect to known facts is established, applicants are not obliged to proffer any evidence of nonobviousness. To establish a *prima facie* case there must be some suggestion or motivation, either in the prior art or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine multiple reference teachings. There must then be a reasonable expectation of success. Finally, the prior art reference or references (when combined) must teach or suggest all the claimed limitations. The prior art reference or

references (when combined) as applied in the most recent Office Action do not teach or suggest all the claimed limitations of the pending claims.

CONCLUSION

In view of the foregoing, it is respectfully submitted that this application is now in condition for allowance. Applicants courteously solicit allowance of the claims in the form of a Notice of Allowance.

Specifically, each of Applicants' claims contains characteristics that are neither disclosed nor suggested by the cited documents. For the reasons detailed herein, Applicants respectfully request that all rejections be reconsidered and withdrawn. This application is in condition for allowance, and notice of the same is earnestly solicited. Should the examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the examiner is invited to contact applicants' representative by telephone at the number indicated below.

Please charge any shortage or credit any overpayment of fees to our Deposit Account No. 12-0080 under the billing code HHI-033US. In the event that a petition for an extension of time is required to be submitted herewith, and the requisite petition does not accompany this response, the undersigned hereby petitions under 37 C.F.R. §1.136(a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized to be charged to the aforementioned Deposit Account.

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Respectfully submitted,

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